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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER	
ALBRECHT, D	
ART UNIT	PAPER NUMBER
115	12

DATE MAILED:

11/01/88

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 8-5-88 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|------------------------------------------------------------------------------------|---------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 9-12 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-8 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 9-12 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner, ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved, ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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1. Claims 9-12 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are rejected for the reasons of record in paragraphs 3 and 4 of Paper No. 6. Note that claims 9, 11 and 12 do not require a first and/or third insulating phase. Is the claimed structure superconducting in the absence of these additional layers? Applicant argues that the claimed structure is superconducting in spite of the teachings in the Jin article. However, the specification does not indicate that such a structure was actually made, or that if it was actually made, it exhibited superconducting properties. In order to resolve the dispute between applicant and the Examiner as to whether the instant application is sufficiently enabling as to the subject matter of these claims, the Examiner requires pursuant to 37 CFR 1.92 that a working model of the claimed subject matter be submitted. With respect to claims 9, 11 and 10 applicant is required to submit a working model that does not contain either the first or third layered phases recited in claim 10. With respect to claim 12, the product made by said process would be sufficient to comply with the requirement for a working model. Any working models submitted should be accompanied by a Declaration stating the superconducting

temperature and current densities of the resulting products.

2. Claims 9-12 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are rejected for the reasons of record in paragraph 3 of Paper No. 9. Applicant has pointed out that the rejection in this paragraph and the previous one might have also been made under 35 U.S.C. 101. It is the Examiner's understanding that rejections related to claims being inoperatively broad may be made under either 35 U.S.C. 101 or 112. It is the Examiner's position that the claimed subject matter would not be expected to be superconducting when "y" is in the range of 2 to 3. This rejection can be overcome by submitting a working model where "y" is about 2 for the oxide complex as a whole. Claims that are broad enough to read on a significant number of inoperative species are properly rejected for this reason. See In re Cook, 169 U.S.P.Q. 298, 302 and In re Corkill, 226 U.S.P.Q. 1005, 1009.

3. In line 6 of claim 9 the word "scadium" should be changed to --scandium--. Correction is required.

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the

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shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. An inquiry concerning this communication should be directed to Dennis L. Albrecht at telephone number (703) 557-8773.

10-28-88:cdc



DENNIS ALBRECHT
PRIMARY EXAMINER
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